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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,626	10/11/2001	Robert E. Haines	10007582-1	1665

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

MEUCCI, MICHAEL D

ART UNIT	PAPER NUMBER
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2142

MAIL DATE	DELIVERY MODE
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11/15/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/976,626

Applicant(s)

HAINES ET AL.

Examiner

Michael D. Meucci

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-16, 18-23 and 25-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-16, 18-23 and 25-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

1. This action is in response to the request for reconsideration filed 29 August 2007.
2. Claims 1-8, 10-16, 18-23, and 25-35 are currently pending.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-7 rejected under 35 U.S.C. 103(a) as being unpatentable over Kageyama (U.S. 6,333,790 B1) in view of Ishizuka (U.S. 2002/0065873 A1).
 - a. Regarding claim 1, Kageyama teaches: receiving an electronic message including hard copy output engine configuration data from an undesignated website, wherein the electronic message designates a hardcopy output engine to be configured; and configuring the hard copy output engine using the configuration data (lines 13-41 of column 3 and lines 33-57 of column 15). Kageyama does not explicitly teach: the electronic message being transmitted through a firewall. However, Ishizuka discloses: "Moreover, alternate servers enable the printer addresses and the associated printer drivers to be stored on servers protected by firewalls and accessible via the LAN 223 (paragraph [0030] on pages 2-3). It would have been obvious for one of ordinary

skill in the art at the time of the applicant's invention to transmit the electronic message through a firewall. Firewalls protect the servers (paragraph [0030] on page 2) by preventing unauthorized access to the servers. It is for this reason that one of ordinary skill in the art at the time of the applicant's invention would have been motivated to transmit the electronic message through a firewall in the system as taught by Kageyama.

b. Regarding claim 2, Kageyama teaches: wherein receiving the electronic message comprises receiving an email at the hard copy output engine and wherein configuring comprises configuring the hard copy engine via an embedded web server contained in the hard copy output engine using the configuration data (lines 13-41 of column 3).

c. Regarding claim 3, Kageyama teaches: wherein receiving the electronic message comprises receiving an email (lines 13-41 of column 3).

d. Regarding claim 4, Kageyama teaches: wherein receiving the electronic message comprises: receiving an email at a first user station (lines 13-41 of column 3); and forwarding the email to the hard copy output engine (lines 31-39 of column 3). While Kageyama teaches: receiving the email at the first station, Kageyama does not explicitly teach: receiving the email through the firewall at the first station. However, the use of firewalls has been discussed above in regards to claim 1 in which the same reasoning applies.

e. Regarding claim 5, Kageyama teaches: configuring includes setting a threshold for an element chosen from a group consisting of: pigmentation material, marking material, number of hours of operation and number of sheets

of print media consumed (lines 8-21 of column 12). Kageyama does not explicitly teach: wherein receiving the electronic message comprises receiving an XML script. However, Ishizuka discloses: "Thus, when a user has identified information which she wishes to print, and the information is provided on the Internet 102 in an HTML or XML file, then the wireless mobile device 106 transmits the file to the print server 413 which interprets the file and subsequently sends the formatted information to the printer 110," (paragraph [0044] on page 4). It would have been obvious for one of ordinary skill in the art at the time of the applicant's invention to receive the electronic message as an XML script. "HTML and XML are both markup languages. Markup language files include directions that tell browsers how to display a document having graphics and/or text. According to an embodiment of the invention, the print server 413 includes browser software or the like configured to interpret HTML and XML files," (paragraph [0044] on page 4 of Ishizuka). It is for this reason that one of ordinary skill in the art at the time of the applicant's invention would have been motivated to receive the electronic message as an XML script in the system as taught by Kageyama.

f. Regarding claim 6, Kageyama teaches: wherein the hard copy output engine is chosen from a group consisting of: facsimile machines, photocopiers, and printers (lines 50-61 of column 1).

g. Regarding claim 7, Kageyama teaches: wherein the configuration data include data prepared by: determining a make and model for the hard copy output engine (Fig. 10); determining a serial number for the hard copy output

engine (Fig. 10); and determining user thresholds for consumables associated with the hard copy output engine (lines 8-21 of column 12).

h. Claims 8 and 10-13 contain limitations similar to those disclosed in claims 1-7 and are rejected under the same rationale.

i. Claims 14-16 and 18-20 contain limitations similar to those disclosed in claims 1-7 and are rejected under the same rationale.

j. Claims 21-23, 25, and 26 contain limitations similar to those disclosed in claims 1-7 and are rejected under the same rationale.

k. Claims 27-35 contain limitations similar to those disclosed in claims 1-7 and are rejected under the same rationale.

Response to Arguments

5. Applicant's arguments filed 29 August 2007 have been fully considered but they are not persuasive.

6. (A) Regarding claim 1, the applicant argues that Kageyama does not teach receiving an electronic message including hard copy output engine configuration data from an undesignated website. The examiner respectfully disagrees.

As to point (A), applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims

patentably distinguishes them from the references. However, Kageyama discloses: "In the operation of this system, the second computer transmits information for proposing updating of a program and data of the printer to the printer controller; and the printer controller transmits the proposal information to the first computer. The first computer transmits updating request information for requesting an update of the program and the data to the printer controller; and the printer controller transmits the updating request information to the second computer. The second computer reads the requested program and the requested data, and then transmits the requested program and the requested data to the printer controller. The printer controller receives and stores the program and the data, and then transmits updating completion information concerning the program and the data to the first computer," (lines 20-28 of column 3). The argued limitation is clearly taught by the cited portion except for the use of firewalls, for which Ishizuka was incorporated under 35 U.S.C. 103(a). While many references could have been incorporated to teach the user of a firewall in a network, Ishizuka explicitly teaches using servers protected by firewalls for storing driver information and accessing these drivers via the LAN. As such, the rejection remains proper and is maintained by the examiner.

7. (B) Regarding claims 2, 8, 15, 20, and 22, the applicant argues that Kageyama does not teach receiving an email including hard copy output engine configuration data. The examiner respectfully disagrees.

As to point (B), applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. However, it is clear that the configuration data is transmitted from a server to the hard copy output engine as an electronic message. "In the operation of this system, the second computer transmits information for proposing updating of a program and data of the printer to the printer controller," (lines 20-22 of column 3 in Kageyama) clearly provides for updating the printer configuration. As such, the rejection remains proper and is maintained by the examiner.

8. (C) Regarding claim 3, the applicant's arguments are similar to those discussed in point (B) above.

9. (D) Regarding claims 4, 11, 14, and 21, the applicant's arguments are similar to those discussed in point (B) above.

10. (E) Regarding claims 5 and 26, the applicant contends that Kageyama and Ishizuka do not teach receiving an electronic message comprising XML script including hard copy output engine configuration data. The examiner respectfully disagrees.

As to point (E), applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable

invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. However, Ishizuka discloses: "In any event, PDF, HTML, and XML files enable wireless mobile device 106 to print using printer 110 whether or not the wireless mobile device is utilizing the printer driver associated with the printer 110," (paragraph [0044] on page 4). From this citation, it is clear that printer configuration data is sent in the message because it states that the mobile device will use the printer, even if the mobile device does not use the printer's current configuration data. The applicant's remaining arguments for these claims are similar to those discussed in point (B) above. As such, the rejection remains proper and it maintained by the examiner.

11. (F) Regarding claims 27-35, the applicant contends that Kageyama and Ishizuka do not teach forming hardcopy output engine configuration on a first side of a firewall based upon input received from a second side of the firewall. The examiner respectfully disagrees.

As to point (E), applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. However, Kageyama discloses: "The first computer transmits updating request information for requesting an update of the program and the data to the printer controller; and the printer controller transmits the updating request information to the second computer. The second computer reads the requested program and the requested

data, and then transmits the requested program and the requested data to the printer controller. The printer controller receives and stores the program and the data, and then transmits updating completion information concerning the program and the data to the first computer," (lines 22-43 of column 3), which clear teaches configuration data being formed at one end of the system and being transmitted to the other end of the system. Ishizuka was incorporated by reference to teach the use of a firewall in the system, for the same reasons it was incorporated in the rejection of claim 1. As such the rejection remains proper and is maintained by the examiner.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Meucci at (571) 272-3892. The examiner can normally be reached on Monday-Friday from 9:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell, can be reached at (571) 272-3868. The fax phone number for this Group is 571-273-8300.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [michael.meucci@uspto.gov].

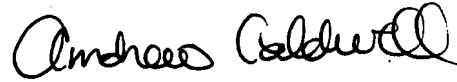
All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR

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system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Andrew Caldwell". The signature is fluid and cursive, with the first name "Andrew" and last name "Caldwell" clearly distinguishable.

ANDREW CALDWELL
ADVISORY PATENT EXAMINER